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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/641,095	08/17/2000	Donald B. Benson	40016420-0001	5295

26565 7590 05/04/2004

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EXAMINER

WOO, RICHARD SUKYOON

ART UNIT PAPER NUMBER

3629

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/641,095

Applicant(s)

BENSON, DONALD B.

Examiner

Richard Woo

Art Unit

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ML

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-6 and 8-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28 is/are allowed.
- 6) ☒ Claim(s) 1, 3-6, 8, 10-12, 16-17, 19-20, 24-27 is/are rejected.
- 7) ☒ Claim(s) 9, 13-15, 18, 21-23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

- 1) Applicant's response filed on January 30, 2004 is acknowledged.
- 2) Applicant's arguments filed January 30, 2004 have been fully considered but they are not persuasive.

In response to applicant's argument that Mayer does not teach or disclose the sortation device, the examiner respectfully invites the applicant's attention to the sortation device (60) in Fig. 5 of Mayer. Although Mayer does not label the device as the sortation device of amended claim, the device is located after the stacked publications are placed on a conveyer. Furthermore, Mayer discloses the sortation system and method of sorting by a mail rate (see col. 12, lines 60-66 to see how Mayer even counts the minimum quantity of the publications to comply with a certain mail rate {e.g. a second class mail in this case}). Inherently, the sortation of device (60) of Mayer must sort each of the plurality of diverse publications by the above cited mail rate for sorting to maximize postal discounts.

In response to applicant's argument that Mayer does not teach nor suggest the sortation device for receiving the plurality of diverse publications merged by the merge stream and sorting each of plurality of diverse publications by a mail rate, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the

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intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

3) The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

4) Claims 1, 3-6, 8, 10-12, 16-17, 19-20 and 24-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Mayer et al. (US 5,287,976).

W.R.T. Claim 1:

Mayer et al. discloses a system comprising:

a bindery for binding a plurality of signatures, the bindery binding the plurality of signatures to create a plurality of first publications and a plurality of second publications, each of the plurality of first publications and each of the plurality of second publications being an order, the order identifying each of the plurality of first and second publications with each of the plurality of recipients (see Figs. 1, 4-6 and the description thereof; abstracts; and Claims); and

a co-mailer (28' in Fig. 5) comprising:

a merge stream for merging the plurality of first publications and the second publications in the order to mail the diverse publications to the plurality of recipients (see 28'); and

a sortation device (60) (see the above Response to Argument for details).

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W.R.T. Claim 3: Mayer et al. further discloses the system, wherein the bindery binds the plurality of first publications and a second bindery binds the plurality of second publications (see Figs. 1, 4-6 and the description thereof; abstracts; and Claims);

W.R.T. Claim 4: Mayer et al. further discloses the system, wherein the plurality of diverse publications comprises magazines, catalogs, books...;

W.R.T. Claim 5: Mayer et al. further discloses the system, wherein the order is maintained in a verified sequence list, the list being transferred from the bindery to the co-mailer (see "mailing information", col. 7, lines; Figs. 1, 4-6 and the description thereof; abstracts; and Claims);

W.R.T. Claim 6: Mayer et al. further discloses the system comprising a bindery bundling device for stacking and wrapping (50) the plurality of publications in the order (see Fig. 5 and the description thereof);

W.R.T. Claim 8: Mayer et al. further discloses the system comprising a bundling device for stacking, labeling and wrapping the plurality of diverse publications, being in communication with the co-mailer (see Supra);

W.R.T. Claim 10: Mayer et al. further discloses the system including a co-mailer verification device (the central processing unit 32), the device verifying the order of each of the diverse publications using an identifier information (col. 6, lines 35-61);

W.R.T. Claim 11: Mayer et al. further discloses the system including a bindery verification device, verifying the order of each of the plurality of publications (see Figs. 1, 4-6 and the descriptions thereof);

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W.R.T. Claim 12: Mayer et al. further discloses the system, wherein the order is contained in a verified sequence list, the list created by a bindery sequence list module in communication with a bindery control module, the control module transmitting the verified sequence list to the bindery for performing a first print of an identifier information (col. 1, line 12 – col. 5, line 53; see Figs. 1, 4-6 and the description thereof; abstracts; and Claims);

W.R.T. Claim 16: Mayer et al. further discloses the system including a co-mailer control module for verifying on a merge stream on the co-mailer; and

W.R.T. Claim 17: Mayer et al. further discloses the system, wherein the co-mailer further has a co-mailer control module (the central processing unit), the control module driving a sortation device, the control module driving a bundling of the diverse publications leaving the sortation device (see Figs. 1, 4-6).

W.R.T. Claims 19 and 24:

Mayer et al. discloses a method comprising:

providing a unique order to a binder, the unique order defining an order that each of a plurality of publications are bound by the bindery (col. 1, line 12 – col. 5, line 53; see Figs. 1, 4-6 and the description thereof; abstracts; and Claims);

binding, by the bindery, a plurality of signatures to create the publications, each of the plurality of publications being in the unique order (*Id.*);

merging the publications in the order to form the diverse publications;

sorting the plurality of diverse publications merged by a mail rate (see the above Response to Arguments for details); and
sending the diverse publications to the recipients (see Supra).

W.R.T. Claim 20:

Mayer et al. further discloses the method comprising:
providing the order in a form of a record list to a bindery sequence list module in communication with bindery, the record list containing an identifier information for each of recipients (col. 1, line 12 – col. 5, line 53; see Figs. 1, 4-6 and the description thereof; abstracts; and Claims); and
sequencing the record list in a predetermined sequence to obtain a sequence list.

W.R.T. Claim 25:

Mayer et al. discloses a system comprising:
a co-mailer for combining the plurality of diverse publications, the co-mailer merging the plurality of diverse publications (col. 1, line 12 – col. 5, line 53; see Figs. 1, 4-6 and the description thereof; abstracts; and Claims); and
a sortation device (60) coupled and in communication with the co-mailer, the sortation device sorting each of the plurality of diverse publications from the co-mailer (see the above Response to Arguments for details).

W.R.T. Claim 26:

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Mayer et al. discloses a method comprising:

co-mailing the plurality of diverse publications by merging the plurality of diverse publications in an order (col. 1, line 12 – col. 5, line 53; see Figs. 1, 4-6 and the description thereof; abstracts; and Claims); and

sorting each of the plurality of diverse publications from the co-mailer to deliver each of the diverse publications to the plurality of recipients (see the above Response to Arguments for details).

W.R.T. Claim 27:

Mayer et al. discloses a method comprising:

binding, by a bindery, a plurality of signatures to create a plurality of first publications and second publications (col. 1, line 12 – col. 5, line 53; see Figs. 1, 4-6 and the description thereof; abstracts; and Claims);

bindery printing, at the bindery, an identifier information on each of the publications to identify each of the recipients; and

co-mailing the diverse publications by:

merging the first publications with the second publications;

sorting the plurality of diverse publications merged by a mail rate (see the above Response to Arguments for details); and

co-mailer printing the mail rate at the co-mailer on each of the diverse publications.

Allowable Subject Matter

- 5) Claim 28 is allowed.
- 6) Claims 9, 13-15, 18, 21-23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

- 7) **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 703-308-7830. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.



Richard Woo
Patent Examiner
GAU 3629
April 30, 20004

JOHN G. WEISS
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